REMARKS

Claims 1, 5-13 and 16-22 are pending in this application. By this Amendment, claim 1 is amended and claim 2 is canceled. No new matter is added.

I. Information Disclosure Statement

Applicants' copy of the June 27, 2003 PTO-1449 Form initialed by the Examiner and returned with the June 6, 2005 Office Action is not initialed to indicate that reference 1 was considered by the Examiner. Applicants request that the Examiner consider reference 1 submitted with the June 27, 2003 Information Disclosure Statement and return a copy of the June 27, 2003 PTO-1449 Form with reference 1 initialed as considered.

II. Request for a Better Translation of Narumiya

Applicants' English translation of Narumiya, Japanese Patent Publication No. 64-86504[1], provided by the Patent Office only consists of the Abstract and constitution, which are confusing and unclear. Applicants request that the Patent Office provide a better translation so that Applicants are afforded an opportunity to evaluate the merits of Narumiya.

III. The Claims Are Patentable over the Applied References

A. Tomono, Ozawa, and Moro

The Office Action rejects claims 1, 2 and 5-11 under 35 U.S.C. §103(a) over U.S. Patent No. 6,358,432 to Tomono et al. (Tomono) in view of U.S. Patent Application Publication No. 2003/0155548 to Ozawa et al. (Ozawa), and further in view of U.S. Patent No. 5,651,841 to Moro et al. (Moro). Applicants respectfully traverse the rejection.

Regarding independent claim 1, the applied references fail to disclose all the features of the claims because (1) one of ordinary skill would not have made the proposed

[1] The Office Action identifies Narumiya as JP 1-86504, the number provided to the English translation. The Japanese original bears the number 64-86504.

combination and (2) even under the proposed combination, all the claimed features are not taught.

Tomono discloses an inductor element 1 including a cylindrical core 2 supporting a coiled winding 3 (Fig. 1; col. 3, lines 21-25). The cylindrical core 2 is disclosed as comprising a ferrite powder dispersed in a resin (col. 2, lines 53-57). This material is suitable for a high frequency inductor (col. 2, lines 45-55).

Regarding independent claim 1, the Office Action acknowledges that Tomono fails to disclose (1) the base material being a solidified hydraulic composition (2) the magnetic particles having a coercive force of no more than 50 Oersteds. The Office Action alleges that Ozawa cures Tomono's deficiency of feature (1) above.

Ozawa discloses a hydraulic composition for binding magnetic particles to produce a magnet that exhibits excellent corrosion and heat resistance, and high strength (paragraph [0011]). The permanent magnet is formed from magnetic powder, preferably a rare earth element-hard magnetic powder, in a hydraulic composition that is cured (paragraph [0012]). The hydraulic composition is cured by letting the product stand at room temperature until matured (paragraph [0050]). The permanent magnet of Ozawa, however, has a magnetic force that is extremely strong, 7 kOe (kilo-Oersteds) or more (paragraph [0055]).

As a result of the magnetic strength of Ozawa's magnet, the magnet would generate heat if used as a magnetic core and would eventually burn off the surrounding coil of the magnet. One of ordinary skill in the art would have known this and thus would not have considered the magnet of Ozawa as a candidate for use as a magnetic core. Thus, one of ordinary skill in the art would not have been motivated to combine Tomono and Ozawa. For the foregoing reasons, Applicants request withdrawal of the rejection.

However, even if the references are combined as proposed, the references fail to disclose "wherein the magnetic particle is at least one of iron powder, ferrite powder, and magnetite powder.

The Office Action cites to Moro as curing Tomono's deficiency of feature (2) above.

Moro discloses a powder magnetic core formed by compressing a ferromagnetic metal powder (Fe-Al-Si) and an insulating agent and then annealing the compressed body (Abstract). Moro discloses that silicon resin is used for the insulating agent and that silicon resin "in a narrow sense is necessarily used" (col. 7, lines 1-3). The annealing reduces the coercive forces in the magnetic particles by relaxing the stress in the magnetic particles. Moro discloses that sufficiently low coercive forces can be obtained by the use of spherical magnetic particles (col. 2, lines 37-40). In some cases, the coercive force of the core, upon annealing, can be 0.25 Oersteds or lower (col. 10, lines 13-17). Moro discloses that annealing preferably takes place at 500° to 800°C (col. 9, lines 14-31).

Because Moro, cited by the Office Action, discloses a Fe-Al-Si alloy that produces a ferromagnetic core having reduced coercive forces, the proposed combination fails to disclose the claimed iron powder, ferrite powder and magnetite powder. For the foregoing reasons, Applicants request withdrawal of the rejection.

B. Narumiya, Ozawa and Moro

The Office Action rejects claims 12, 13 and 16-22 under 35 U.S.C. §103(a) over Japanese Patent Publication No. 64-86504[2] to Narumiya in view of Ozawa, and further in view of Moro. Applicants respectfully traverse the rejection.

[2] See footnote 1 on page 9.

Regarding independent claim 12, the applied references failed to disclose all of the features of the claims because one of ordinary skill in the art would not have made the proposed combination.

Narumiya appears to disclose dispersing magnetic powder in an organic binder to produce a magnetic shielding material (Abstract) which is rolled or compressed into a sheet as well as use of magnetic particles and resin used as a coating or paint (constitution). The magnetic particles of Narumiya are tabular in shape and the coating is used to improve shielding against magnetic fields parallel to the plane of the coating (constitution).

Regarding independent claim 12, the Office Action admits that Narumiya fails to disclose a hydraulic composition, but alleges that Ozawa and Moro, discussed above, cure this deficiency.

Ozawa discloses a binding material which requires a long curing process. One of ordinary skill in the art would understand that if the binding material of Ozawa was used for the binding material of the Narumiya shielding sheet, the resulting product would not be capable of being rolled/compressed into sheets once secured.

Thus, modifying Narumiya by the disclosure of Ozawa would render Narumiya unsuitable for its intended use of providing a shielding material in violation of MPEP §2143.01(V). Thus, one of ordinary skill in the art would not have made the proposed combination.

Moro discloses magnetic particles of Fe-Al-Si that are spherical in shape, suspended in a resin binder, and annealed to 500°C or more. If the magnetic particles of Moro were substituted for the tabular magnetic particles in Narumiya, the required annealing temperature of 500°C or more (1) would burn the sheet or coating/paint layer due to the layer's thinness, or (2) would be impossible to do because the coating in Narumiya, once applied to an object,

would require the object to be subjected to the annealing temperatures, likely rendering the underlying object inoperable.

Because one of ordinary skill in the art would understand that combining either or both Ozawa and Moro with the teachings of Narumiya would render the coating/paint layer of Narumiya unsuitable for its intended purpose, in violation of MPEP §2143.01(V), the rejection is improper. Applicants request withdrawal of the rejection.

I. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Jonathan H. Backenstose
Registration No. 47,399

JAO:JHB/mef

Attachment:
Petition for Extension of Time

Date: December 27, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461